

REMARKS

Claim 15 has been canceled, and claims 1-14 amended to particularly point out and distinctly claim subject matter regarded as the invention.

The office actions states:

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "swelling rapidly" in claim 1, from which the balance of the claims depend, is a relative term which renders the claims indefinite. The term "rapidly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The requisite degree of swelling is unclear.

4. Further, claims 11-14 provide for the use of the beads of claim 1, but, since the claims do not actually set forth the required steps in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

5. Also, claim 15 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. Pp. 2-3.

This ground of rejection is respectfully traversed. The specification defines rapid on page 2, lines 3-5:

By rapid is meant that primary geometry changes of the bead due to swelling caused by the aqueous medium occur within 5 to 20 minutes after the beads are placed in contact with an aqueous medium.

Accordingly, withdrawal of the rejection of claims 1-14 on this ground as indefinite is respectfully requested.

Claims 11-14 have been amended to incorporate the applications set forth on pages 9 and 10 of the specification. Accordingly, withdrawal of the rejection of claims 11-14 as indefinite is respectfully requested.

The office action states:

7: Claims-3-14 are rejected-under 35 U.S.C. 101 because the claimed recitation of a method, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153, USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). P. 3.

Claims 1, 2 and 5-10 positively recite the polymer bead or beads of dry construction incorporating within the dry bead structure a diluent that is highly water-soluble. Manifestly, the claimed bead or beads are a new and useful composition of matter or new and useful improvement thereof.

Claims 11-14 set forth steps involved in the process.

Accordingly, withdrawal of the rejection of claims 3-14 under 35 U.S.C. §101 is respectfully requested.

The office action states:

9. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by US3878310, US4070348, US4229547, US4446261, US5326819, US5549908 and US5858534. While it is unclear exactly what invention(s) applicant is attempting to claim, each of US3878310, US4070348, US4229547, US4446261, US5326819, US5549908 or US5858534 teach polymer beads characterized by various degrees of swelling when in contact with aqueous media. Pp. 3-4.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of

the claimed invention.” *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, “Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim,” 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term “engaging the ball” recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, “Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim.” *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

None of the references disclose the polymer bead incorporating within the dry bead structure a diluent that is highly water-soluble and swells rapidly when placed in contact with

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aqueous media called for by claims 1,2 and 5-10, nor the method of making the novel beads of claims 4 and 5 or the method of using the novel beads of claims 11-14.

Accordingly, withdrawal of the rejection of these claims as anticipated by the seven cited patents is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to each limitation in each rejected claim.

In view of the forgoing cancellation, amendments, and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

Enclosed is a \$510 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, Order No. 04015-005001.

Respectfully submitted,
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